

REMARKS/ARGUMENTS

Claims 1 – 41 in the above-identified application have been cancelled. Claims 42 and 43 have been newly added. No new subject matter has been added by this amendment. Support for newly added claims 42 and 43 can be found, for example, in paragraphs 45 through 51 and paragraphs 60 through 66, respectively.

Upon entry of the foregoing amendment, claims 42 and 43, which are directed to allowable subject matter, will be pending in the application. Reconsideration of the claims as amended by this Amendment is respectfully requested.

Rejection of Claims under 35 U.S.C. 112 Second Paragraph

Claims 1 - 41 stand rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 - 41 have been canceled. Newly added claims 42 and 43 are believed to be in compliance with 35 U.S.C. 112, second paragraph.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 4, 5, 11 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by JP 04-128834. Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a photochromic compound. Therefore, claims 42 and 43 are not anticipated by JP 04-128834.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(e)

Claims 1, 4, 8, 11 and 41 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 5,963,536 (hereafter "Vasic et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a dye containing layer. Therefore, claims 42 and 43 are not anticipated by Vasic et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S. C. 102(b)

Claims 1, 8 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by JP 05-297627 (hereafter "Matsuda et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a crystal violet lactone that fades when irradiated with light. Therefore, claims 42 and 43 are not anticipated by Matsuda et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 8 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 4,735,839 (hereafter "Sato et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a dye containing layer. Therefore, claims 42 and 43 are not anticipated by Sato et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 103(a)

Claims 1, 8 and 41 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious in light of U.S. Patent No. 4,735,839 (hereafter "Sato et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a dye containing layer. Therefore, claims 42 and 43 are not anticipated by Sato et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 1, 8 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 4,237,211 (hereafter "Fanselow"). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a dye containing layer. Moreover, the mechanism claimed in claims 42 and 43 is not reversible. The dye containing layer in Fanselow is reversible. Therefore, claims 42 and 43 are not anticipated by Fanselow.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 1, 4, 5, 8, 11 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 4,527,173 (hereafter "Gupta et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a heat deformable layer that is bounded from the top and bottom. Moreover, the heat deformable layer in Gupta et al. is reversible. Claims 42 and 43 contain the limitation of irreversibility. Claim 42, in particular, has a **polymer layer in communication with**

said data layer, wherein said polymer layer has a first surface that is bounded below by said data layer and a second surface that is unbounded, wherein said second surface permanently and irreversibly transforms from a sufficiently smooth surface that allows the interrogating beam to read the data layer to a sufficiently deformed surface that prohibits at least a portion of the data layer from being read by the interrogating beam after said at least a portion of the data layer is read by the interrogating beam. Therefore, claims 42 and 43 are not anticipated by Gupta et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 8 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. '769 (hereafter "Thomas et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a dye containing layer. Therefore, claims 42 and 43 are not anticipated by Thomas et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(e)

Claims 1, 8 and 41 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,038,207 (hereafter "Wachi"). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a heat deformable layer that is bounded from the top and bottom. Claim 42, in particular, has a polymer layer in communication with said data layer, wherein said polymer layer has a first surface that is bounded below by said data layer and a second surface

that is unbounded, wherein said second surface permanently and irreversibly transforms from a sufficiently smooth surface that allows the interrogating beam to read the data layer to a sufficiently deformed surface that prohibits at least a portion of the data layer from being read by the interrogating beam after said at least a portion of the data layer is read by the interrogating beam. Therefore, claims 42 and 43 are not anticipated by Wachi.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(b)

Claims 1 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,448,551 (hereafter "Miyagawa et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a heat deformable layer that is bounded from the top and bottom. Claim 42, in particular, has a polymer layer in communication with said data layer, wherein said polymer layer has a first surface that is bounded below by said data layer and a **second surface that is unbounded**, wherein **said second surface permanently and irreversibly** transforms from a sufficiently smooth surface that allows the interrogating beam to read the data layer to a sufficiently deformed surface that prohibits at least a portion of the data layer from being read by the interrogating beam after said at least a portion of the data layer is read by the interrogating beam. Therefore, claims 42 and 43 are not anticipated by Miyagawa et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 102(a)

Claims 8 and 41 stand rejected under 35 U.S.C. 102(a) as allegedly being anticipated by U.S. Patent No. 6,011,772 (hereafter "Rollhaus et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a heat deformable layer that is bounded from the top and bottom. Moreover, the deformation of the optical medium disclosed in Rollhaus et al. is the result of hydroscopic material and not due to optical radiation. Furthermore, claims 42 and 43 do not contain the limitations of a dye or oxidizing species. Claim 42, in particular, has a **polymer layer in communication with said data layer, wherein said polymer layer has a first surface that is bounded below by said data layer and a second surface that is unbounded, wherein said second surface permanently and irreversibly transforms from a sufficiently smooth surface that allows the interrogating beam to read the data layer to a sufficiently deformed surface that prohibits at least a portion of the data layer from being read by the interrogating beam after said at least a portion of the data layer is read by the interrogating beam.** Therefore, claims 42 and 43 are not anticipated by Rollhaus et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 103(a)

Claims 8 and 41 stand rejected under 35 U.S.C. 103(a) as allegedly being obvious in light of U.S. Patent No. 6,011,772 (hereafter "Rollhaus et al.") and in view of U.S. Patent No. 5,384,221 (hereafter "Savant et al."). Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not contain the limitation of a heat deformable layer

that is bounded from the top and bottom. Moreover, the deformation of the optical medium disclosed in Rollhaus et al. is the result of hydroscopic material and not due to optical radiation. Furthermore, claims 42 and 43 do not contain the limitations of a dye or oxidizing species. Claim 42, in particular, has a **polymer layer in communication with said data layer, wherein said polymer layer has a first surface that is bounded below by said data layer and a second surface that is unbounded, wherein said second surface permanently and irreversibly transforms from a sufficiently smooth surface that allows the interrogating beam to read the data layer to a sufficiently deformed surface that prohibits at least a portion of the data layer from being read by the interrogating beam after said at least a portion of the data layer is read by the interrogating beam**. Therefore, claims 42 and 43 are not obvious in light of Rollhaus et al. and in view of Savant et al.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims under 35 U.S.C. 101

Claims 3, 6, 7, 10, 13-25 and 28-38 stand rejected under 35 U.S.C. 101 as allegedly claiming the same invention as U.S. Patent No. 6,709,802 and U.S. Patent No. 6,338,933. Claims 1 – 41 have been canceled. Newly added claims 42 and 43 do not claim the same invention as U.S. Patent Nos. 6,709,802 and 6,338,933.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

**Rejection of Claims under the Judicially created doctrine of
Obviousness Type Double Patenting**

Claims 3, 5-7, 10 and 12-41 stand rejected under the judicially created doctrine of obviousness type double patenting in light of U.S. Patent Nos. 6,709,802 and 6,338,933. Claims 1-41 have been canceled. Newly added claims 42 and 43 do not claim the same invention as U.S. Patent Nos. 6,709,802 and 6,338,933. However, Applicants are prepared to submit a terminal disclaimer should Examiner desire.

For the above reasons claims 42 and 43 are believed to be allowable.

Accordingly, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

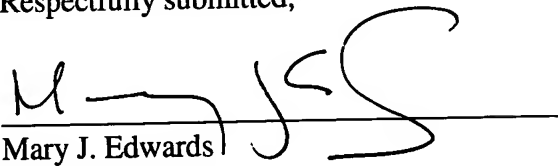
Applicants respectfully request an early and favorable reconsideration and allowance of this application as amended herein. The Examiner is encouraged to contact the undersigned to expedite prosecution of this application.

Applicants also include a petition for a two-month extension of time to extend the period for response up to and including February 20, 2005. An authorization to charge the associated fee of \$450.00 to a credit card accompanies this response.

No other fees are believed to be due in connection with this submission. However, please charge any fees that might be due or credit any overpayment to the credit card listed on the enclosed Form PTO-2038.

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Respectfully submitted,


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